

REMARKS

Reconsideration and allowance respectfully are requested. Entry of the present amendment respectfully is requested at this stage of prosecution under 37 CFR 116(b) because the amendment reduces the number of claims (canceling claims rejected under 35 USC 112), amends the claims solely to overcome other certain formal rejections under 35 USC 112, does not raise any new issues requiring further searching by the Examiner and is for purposes of clarifying issues for appeal.

Applicant thanks the Examiner for extending the courtesy of a telephone interview on August 10, 2006, between the Examiner and Applicant's attorneys, Alan B. Clement (Reg. No. 34,563) and Matthew J. Solow (Reg. No. 56,878). In the interview, the final rejections of all the claims were discussed. Applicant's attorneys pointed out several reasons why they believe that the Okamoto reference (EP 665252) properly is not combinable with the Calahorra reference (EP 428937). Applicant's attorneys also noted that which Applicant claims as the invention still would not be created even if the references were combined. Additionally, Applicant's attorneys argued that the Examiner's new grounds of rejection should have resulted in a non-final rejection because the Calahorra secondary reference had never before been cited by the Examiner. Applicant's attorneys and the Examiner were unable to come to any substantive agreement regarding these issues.

In the Office Action, the Examiner rejected Claims 2 and 4 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. While Applicant does not agree with the rejection, Applicant is canceling Claims 2 and 4 in an effort to speed prosecution of this application to allowance. Therefore, this rejection is rendered moot.

The Examiner then rejected Claims 1-5, 8, 10-12, 15-17, and 19-27 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response, Applicant has canceled Claims 2 and 4, as discussed above. Additionally, Applicant has amended Claim 1 to clarify that the coating is formed from the isocyanate-curing

polyacrylate lacquer. Applicant has also amended Claims 15 and 26 by deleting the recitation of alkoxy ester, thus eliminating any overlap in the claims. All amendments have been made under 37 CFR §1.116 and serve only to put the application into position for allowance. Therefore, Applicant respectfully requests reconsideration and removal of this ground of rejection.

Applicants note with thanks that in the Office Action, the Examiner has withdrawn the rejections of Claims 1-3, 5-16, and 19-27 under 35 U.S.C. 103(a) as being unpatentable over Bock et al. (US Pat. No. 6,020,419) due to Applicant's January 17, 2006 amendment.

The Examiner next rejected Claims 1-5, 8, 10-12, 15-16, and 19-27 under 35 U.S.C. 103(a) as being unpatentable over EP 665252 ("Okamoto" or "the Okamoto reference") taken in view of EP 428937 ("Calahorra" or "the Calahorra reference"). In response, Applicant has canceled Claims 2 and 4 (as discussed above); Applicant respectfully requests reconsideration and removal of this ground of rejection as it applies to the remaining claims.

More particularly, Applicant avers that it would not be obvious to one of ordinary skill in the art to modify the Okamoto reference with the teachings of the Calahorra reference in order to create that which Applicant claims as the invention. That is, Okamoto is concerned with a procedure to obtain **permanent** although removable films on **glass** surfaces. *See, e.g.*, page 2, lines 44-47. In direct contradistinction, Calahorra is concerned with spraying a **temporary** coating onto **plastic sheets**. *See, e.g.*, page 2, lines 35-43. In fact, the Calahorra reference never once mentions the word "glass." In contrast, Applicant's claimed invention is directed towards **durable non-removable** coatings on **glass** surface. The two cited references are simply too remote from each other to be properly combined together. Accordingly, Applicant respectfully submits that the rejection is the result of impermissible hindsight.

Additionally, Okamoto applies a 2-component aqueous lacquer to a glass surface, and, due to the nature of glass, the film is easily separated from the glass surface (though it should be noted that the film, as mentioned above, is permanent; it just does not stay attached to the glass surface). For example, if the invention of Okamoto were mistakenly applied to a glass window, a razor blade could easily be used to remove the Okamoto

invention, which is akin to paint. This is due to glass being a very polar substrate. However, as noted above, Applicant's claimed invention can not be so easily separated from the glass substrate as it is very **durable and non-removable** as well as **permanent**. A person of ordinary skill in the art would consider the invention of Okamoto unsuitable to apply to glass when a **durable and permanent** film is required. *See* Okamoto, p. 12, lines 51-58 (showing that the coating films separated from the glass sheets after one day, seven days, and thirty days). In contrast, Applicant's invention withstands sunlight, heat, and humidity. *See* p. 11, lines 12-14, 24-26; p. 14, lines 1-6.

Applicant further submits that in any event, the claimed invention is entirely different from and not disclosed or taught by Okamoto, on a number of different levels.

Firstly, the present invention is chemically different from that of Okamoto in that the claimed invention does not call for an acrylic copolymer component containing water wherein the acrylic copolymer is dispersed as solid matter in water and instead comprises a solvent for dissolving the polyacrylate. Okamoto, however, requires siloxane bonds. *See* page 10, lines 22-23. Okamoto's copolymeric acrylate-siloxane are chemically distinct from the claimed polyacrylate, which excludes the siloxane component of Okamoto because the claimed polyacrylate is only urethane crosslinked. Therefore, the two coatings are chemically very distinct from each other.

Additionally, the coating of the present invention is hard and nonflexible whereas Okamoto's film can be elongated. *See* Table 2.

Moreover, the film obtained by Okamoto is 200 μ m thick (page 12, line 57). Okamoto does disclose film thicknesses of 1 to 1000 μ m but not in connection with coated glass surfaces. *See* page 10, lines 16-17. The present invention instead requires film thickness of 10 to 50 μ m which relates to the diameter of the particles of 2 to 30 μ m contained in the lacquer. This ensures that the glass coating is opaque and at the same time transparent to light.

Okamoto also does not disclose the masking foil used in the claimed invention. It is not conventional to mask a glass surface to be coated, and none of the references apply a masking film. The Examiner simply states that it is conventional to mask a glass surface without citing references. This must be supported by an affidavit by the Examiner, which was not provided. *See* 37 CFR §1.104. The use and removal of the

masking foil are positive limitations recited by the claimed invention that are not disclosed or taught by any of the applied references.

The Okamoto reference does recite a listing of additives (page 10, lines 10-13), but it does not disclose mineral particles as claimed in claim 1. Recited in the list are metallic particles and coloring pigments. These, however, are not the same as the claimed mineral particles. Furthermore, the dyes of claim 8 are added on top of the mineral particles.

The average particle diameter represents another difference between the claimed invention and the Okamoto reference. The average particle diameter refers to the dispersed copolymer in the aqueous dispersion. However, it can be assumed that there are no other particles of a larger size in Okamoto; otherwise the particle diameters of about 0.01 to about 1 μ m of the disperse phase (page 9, line 25) would not have been given (or, at the very least, are not determinable in the presence of larger particles). It is also likely that because the polyacrylate phase is a dispersion of a polar polymer, it is not possible to disperse mineral particles at the same time without obtaining unwanted coagulation and precipitation of both. *See* page 9, lines 20-25.

The Calahorra reference does not work to not fill in the missing aspects of the Okamoto reference. As an initial matter, the Calahorra reference is directed to a temporary coating which can be simply washed away. *See* page 2, lines 33-36. An isocyanate-cured polyacrylate lacquer as claimed can not be washed off by water. Furthermore, Calahorra is directed to “a wide variety of polymers and copolymers of the type generally used in coating technology. There may be used suitable alkyd resins, vinyl resins, epoxies, polyurethane, acrylics, chlorinated rubber, polycarbonates, polyesters and copolymers of any of these.” Page 2, lines 44-46. None of these are isocyanate-cured polyacrylate lacquers such as those in the present invention.

Additionally, the percentage of matter in the compositions are very different: Calahorra teaches that “[b]ased on parts by weight, compositions of the invention contain typically from about 20 to 50 parts binder, 5 to 20 parts solvents, 0.5 to 3 parts additives, 2 to 15 parts plasticizer, and from about 2 to 20 parts reflective particles (pigments).” Page 2, lines 51-53. No isocyanate or solvent share of 30 wt. % or higher is disclosed, as in the present invention.

Finally, the Calahorra coating is not applied to glass surfaces, it is only applied to plastic sheets (i.e., poly olefins). *See, e.g.*, page 2, lines 42-43; page 3, lines 6-11. In fact, the word “glass” is not mentioned anywhere in the Calahorra reference!

Therefore, even if it were obvious to one of ordinary skill in the art to combine the two cited reference (which it is not), that which Applicant claims as the invention still would not be created, for the reasons discussed above. Therefore, Applicant respectfully requests removal of this ground of rejection.

The Examiner next rejected Claim 17 under 35 U.S.C. 103(a) as being unpatentable over EP 665252 taken in view of EP 428937 and further taken in view of Ellenson et al (U.S. Patent No. 2,969328). Applicant respectfully requests reconsideration and removal of this ground of rejection.

More specifically, Applicant avers that it would not be obvious to one of ordinary skill in the art to combine the Okamoto reference with the Calahorra reference for the reasons discussed above. The addition of the Ellenson patent does not suddenly make it obvious to combine these other two references, thus curing the defect. Even if it were obvious to one of ordinary skill in the art to combine the two references (which it is not), that which Applicant claims as the invention still would not be created, as discussed above. Additionally, the invention as claimed would not be created because Ellenson does not teach the removal of isocyanate-cured polyacrylate lacquers with halogen hydrocarbons. Furthermore, Ellenson does not mention any coatings that contain mineral particles. Therefore, Applicant respectfully requests removal of this ground of rejection.

Finally, in order to aid the Examiner in further understanding the claimed invention, Applicant is submitting photographs of glass manufactured with the coating of the present invention as Exhibit A.

In light of the foregoing Applicant respectfully submits that the pending Claims 1, 3, 5, 8, 10-12, 15-17, and 19-27 of the present application are in proper form for allowance. Favorable consideration and early allowance are therefore respectfully requested and earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Matthew J. Solow', written over a horizontal line.

Matthew J. Solow

Reg. No. 56,878

MAILING ADDRESS

HEDMAN & COSTIGAN, P.C.

1185 Avenue of the Americas

New York, New York 10036

(212) 302-8989